



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,649	11/07/2001	Nobuyoshi Morimoto	5596-00901	9861

7590 07/17/2006  
Robert C. Kowert  
Conley, Rose & Tayon, P.C.  
P.O. Box 398  
Austin, TX 78767

EXAMINER TOMASZEWSKI, MICHAEL	
ART UNIT 3626	PAPER NUMBER

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/045,649	<b>Applicant(s)</b> MORIMOTO, NOBUYOSHI	
	<b>Examiner</b> Mike Tomaszewski	<b>Art Unit</b> 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/7/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Notice To Applicant***

1. This communication is in response to the amendment filed on 5/12/2006. Claims 1 and 20 have been amended. Claims 1-20 remain pending. Examiner neglected to take into account Applicant's preliminary amendment correcting Applicant's priority claim to U.S. Provisional Application No. 60/247,272 filed Nov. 10, 2000. Examiner now acknowledges Applicant's priority claims to the aforementioned application.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 8, 12-15, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parcel Insurance Plan ([www.pipinsure.com](http://www.pipinsure.com)); hereinafter

Art Unit: 3626

Pipinsure), in view of Keuper (DE 44 46 203 A1; see English translation; hereinafter Keuper).

(A) As per amended claim 1, Pipinsure discloses a method for arranging insurance for an item, wherein the method comprises:

- (1) receiving a request to insure the item being shipped from an origination to a final destination (Pipinsure: pg. 8);
- (2) searching a database for a cost effective insurance, wherein the cost effective insurance provides a specified level of insurance coverage for the item (Pipinsure: pg. 1);
- (3) generating a data file comprising at least the following:
  - (i) item information (Pipinsure: pg. 8); and
  - (ii) insurer information (Pipinsure: pg. 8).

Pipinsure, however, fails to expressly disclose a method for arranging insurance for an item, wherein the method comprises:

- (4) storing the data file in a memory device that accompanies the item.

Nevertheless, these features are old and well known in the art, as evidenced by Keuper. In particular, Keuper discloses a method for arranging insurance for an item, wherein the method comprises:

- (4) storing the data file in a memory device that accompanies the item  
(Keuper: abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Keuper with the teachings of Pipinsure with the motivation of acquiring shipment-handling data on an item (Keuper: abstract).

(B) As per claim 2, Pipinsure fails to expressly disclose the method as recited in claim 1, wherein the memory device is configured to allow the data file to be updated at any time before, during or after the shipment.

Nevertheless, these features are old and well known in the art, as evidenced by Keuper. In particular, Keuper discloses the method as recited in claim 1, wherein the memory device is configured to allow the data file to be updated at any time before, during or after the shipment (Keuper: abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Keuper with the teachings of Pipinsure with the motivation of acquiring shipment-handling data on an item (Keuper: abstract).

(C) As per claim 3, Pipinsure fails to *expressly* disclose the method as recited in claim 1, further comprising packing the item in a container for shipping, wherein the container is configured to fit with multiple other containers in a carrier.

Art Unit: 3626

Nevertheless, these features are old and well known in the art, as evidenced by Keuper. In particular, Keuper discloses the method as recited in claim 1, further comprising packing the item in a container for shipping, wherein the container is configured to fit with multiple other containers in a carrier (Keuper: abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Keuper with the teachings of Pipinsure with the motivation of acquiring shipment-handling data on an item (Keuper: abstract).

(D) As per claim 8, Pipinsure discloses the method as recited in claim 1, wherein the data file further comprises contact information for at least one of the insurance companies that will insure the item (Pipinsure: pg. 2-3).

(E) As per claim 12, Pipinsure fails to *expressly* disclose the method as recited in claim 1, wherein the data tile further comprises item weight information.

Nevertheless, these features are old and well known in the art, as evidenced by Keuper. In particular, Keuper discloses the method as recited in claim 1, wherein the data tile further comprises item weight information (Keuper: abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Keuper with the teachings of Pipinsure with the motivation of acquiring shipment-handling data on an item (Keuper: abstract).

Art Unit: 3626

(F) As per claim 13, Pipinsure fails to *expressly* disclose the method as recited in claim 1, wherein the data file further comprises item handling information.

Nevertheless, these features are old and well known in the art, as evidenced by Keuper. In particular, Keuper discloses the method as recited in claim 1, wherein the data file further comprises item-handling information (Keuper: abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Keuper with the teachings of Pipinsure with the motivation of acquiring shipment-handling data on an item (Keuper: abstract).

(G) As per claim 14, Pipinsure fails to *expressly* disclose the method as recited in claim 1, wherein the data file further comprises item content information.

Nevertheless, these features are old and well known in the art, as evidenced by Keuper. In particular, Keuper discloses the method as recited in claim 1, wherein the data file further comprises item content information (Keuper: abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Keuper with the teachings of Pipinsure with the motivation of acquiring shipment-handling data on an item (Keuper: abstract).

Art Unit: 3626

(H) As per claim 15, Pipinsure discloses the method as recited in claim 1, wherein the data file further comprises insurance information (Pipinsure: pg. 8).

(I) Claim 20 substantially repeats the same limitations as claim 1 and therefore, is rejected for the same reasons given for claim 1 and incorporated herein.

4. Claims 4, 6, 9, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pipinsure and Keuper, as applied to claim 1 above, and further in view of Kadaba et al. (6,285,916; hereinafter Kadaba).

(A) As per claim 4, Pipinsure discloses the method as recited in claim 1, further comprising forwarding copies of at least a portion of the data file via the network to at least one insurance company (Pipinsure: pg. 8).

Pipinsure, however, fails to expressly disclose the method as recited in claim 1, further comprising forwarding copies of at least a portion of the data file via the network to one or more of the parties involved in the shipping, wherein the parties include at least an originator of the request to ship the item, a recipient of the item at the final destination.

Nevertheless, these features are old and well known in the art, as evidenced by Keuper. In particular, Keuper discloses the method as recited in claim 1, further comprising forwarding copies of at least a portion of the data file



Art Unit: 3626

via the network to one or more of the parties involved in the shipping, wherein the parties include at least an originator of the request to ship the item, a recipient of the item at the final destination (Kadaba: abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Kadaba with the combined teachings of Pipinsure and Keuper with the motivation of providing an improved parcel tracking system capable of sharing parcel data with other computers (Kadaba: col. 3, lines 40-64).

(B) As per claim 6, Pipinsure fails to *expressly* disclose the method as recited in claim 1, further comprising forwarding a copy of the data file via a network to a central server.

Nevertheless, these features are old and well known in the art, as evidenced by Keuper. In particular, Keuper discloses the method as recited in claim 1, further comprising forwarding a copy of the data file via a network to a central server (Kadaba).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Kadaba with the combined teachings of Pipinsure and Keuper with the motivation of providing an improved parcel tracking system capable of sharing parcel data with other computers (Kadaba: col. 3, lines 40-64).

Art Unit: 3626

(C) As per claim 9, Pipinsure fails to *expressly* disclose the method as recited in claim 1, further comprising storing the data file on a server connected to a network, wherein the server provides access to the data file via the network.

Nevertheless, these features are old and well known in the art, as evidenced by Keuper. In particular, Keuper discloses the method as recited in claim 1, further comprising storing the data file on a server connected to a network, wherein the server provides access to the data file via the network (Kadaba: abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Kadaba with the combined teachings of Pipinsure and Keuper with the motivation of providing an improved parcel tracking system capable of sharing parcel data with other computers (Kadaba: col. 3, lines 40-64).

(D) Claim 19 substantially repeats the same limitations as claims 1, 6, and 9 and therefore, is rejected for the same reasons given for claims 1, 6, and 9 and incorporated herein.

5. Claims 5, 7, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pipinsure and Keuper, as applied to claim 1 above, and further in view of Official Notice.

Art Unit: 3626

(A) As per claim 5, Pipinsure fails to *expressly* disclose the method as recited in claim 1, further comprising forwarding copies of the data file via the network to one or more predetermined email addresses.

Nevertheless, Official Notice is taken that it is old and well known within the computer arts to transmit information via a network to an email address. The technique of using networks, such as, the Internet, intranets, wide area networks (WANs), local area networks (LANs), to transmit information across their lines to email addresses using, *inter alia*, Outlook Express, Hotmail, and Yahoo was notoriously well known and widely used at the time of the present invention and was developed to, *inter alia*, facilitate the transmission and sharing of information.

One of ordinary skill in the art would have found it obvious at the time of the invention to combine the technique of transmitting information via a network to an email address with the combined teachings of Pipinsure and Keuper with the motivation of facilitating the transmission and sharing of information.

(B) As per claim 7, Pipinsure fails to *expressly* disclose the method as recited in claim 1, further comprising shipping the item using the least expensive routing.

Nevertheless, Official Notice is taken that it is old and well known within the shipping and parcel delivery arts to ship items using the least expensive routing. This technique was well known and widely used at the time of the present invention by, for example, price conscientious consumers striving to

Art Unit: 3626

minimize expenses and by corporate entities striving to maximize profits/revenue through cost containment.

One of ordinary skill in the art would have found it obvious at the time of the invention to combine the technique shipping items using the least expensive routing with the combined teachings of Pipinsure and Keuper with the motivation of minimizing costs/expenses and/or maximizing profits/revenues.

(C) As per claim 10, Pipinsure fails to *expressly* disclose the method as recited in claim 1, wherein storing the data file comprises data in an XML format.

Nevertheless, Official Notice is taken that it is old and well known within the computer arts to store data in eXtensible Markup Language (XML) format. This technique was well known and widely used at the time of the present invention. For example, corporate organizations routinely formatted their documents in XML to create their own customized "tags," thereby enabling the definition, transmission, validation, and interpretation of data between applications and between organizations.

One of ordinary skill in the art would have found it obvious at the time of the invention to combine the technique storing data in XML format with the combined teachings of Pipinsure and Keuper with the motivation facilitating the transmission of data between applications and/or organizations over a network.

(D) As per claim 11, Pipinsure fails to *expressly* disclose the method as recited in claim 1, wherein the network data is exchanged in an XML format.

Art Unit: 3626

Nevertheless, Official Notice is taken that it is old and well known within the computer arts to exchange network data in an XML format for substantially the same reasons given for claim 10 above and incorporated herein.

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pipinsure and Keuper, as applied to claim 1 above, and further in view of eBay (<http://www.ebay.com>; hereinafter eBay).

(A) As per claim 16, Pipinsure fails to expressly disclose the method as recited in claim 1, wherein the data file further comprises one or more digital images of the item before, during, or after shipping.

Nevertheless, this feature is old and well known in the art, as evidenced by eBay. In particular, eBay discloses the method as recited in claim 1, wherein the data file further comprises one or more digital images of the item before, during, or after shipping (eBay: Why eBay is Safe; How to Add a Photo to Your Item Listing).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of eBay with the combined teachings of Pipinsure and Keuper with the motivation of providing a means for archiving the condition of an item for insurance claims purposes (eBay: Why eBay is Safe).

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pipinsure and Keuper, as applied to claim 1 above, in further view of Chen et al. (5,504,674; hereinafter Chen), and further in view of knowledge generally available to one having ordinary skill in the art.

(A) As per claim 17, Pipinsure fails to expressly disclose the method as recited in claim 1, wherein the data file further comprises one or more digital images of the item showing the physical condition of the item upon receipt.

Nevertheless, this feature is old and well known in the art, as evidenced by Chen and knowledge generally available to one having ordinary skill in the art. In particular, Chen discloses the method as recited in claim 1, wherein the data file further comprises one or more digital images of the item showing the physical condition of the item upon receipt (Chen: abstract). Furthermore, taking photographs of items to document the physical condition of the items at different time frames (e.g., after shipment, etc.) for, *inter alia*, evidentiary and/or insurance claim purposes is notoriously well known. For example, customers of parcel carriers, such as, FedEx™ and UPS™, are advised to document (e.g., photograph) any damage to their parcels/goods upon receipt in order to ensure successful insurance claims. Another example involves car rental agencies. Before a customer rents a vehicle from a car rental agency the agency meticulously documents the condition of a vehicle. Upon return of the vehicle,

Art Unit: 3626

the car rental agency will photograph any damage to their vehicle to maintain the proper documentation for insurance claims purposes.

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Chen and knowledge generally available to one having ordinary skill in the art with the combined teachings of Pipinsure and Keuper with the motivation of providing a means for assessing damage for insurance claim processing purposes (Chen: abstract).

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pipinsure and Keuper, as applied to claim 1 above, and further in view of Kepler (5,347,845; hereinafter Kepler).

(A) As per claim 18, Pipinsure fails to *expressly* disclose the method as recited in claim 1, wherein the memory device comprises an air testing device configured to test air samples for contaminants and to store test results in the data file.

Nevertheless, these features are old and well known in the art, as evidenced by Keuper and Kepler. In particular, Keuper and Kepler disclose the method as recited in claim 1, wherein the memory device (Keuper: abstract) comprises an air testing device configured to test air samples for contaminants (Kepler: abstract; col. 2, lines 25-35) and to store test results in the data file (Keuper: abstract).

Art Unit: 3626

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Keuper with the teachings of Pipinsure and Kelper with the motivation of acquiring shipment-handling data on an item (Keuper: abstract).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Kepler with the combined teachings of Pipinsure and Keuper with the motivation of detecting the presence of contaminants in shipping containers (Kepler: col. 2, lines 33-35).

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied art teaches an environmental test apparatus with memory for testing variables (e.g., temperature, vibration, impact, etc.) effecting cargo packages during shipment (5,610,344).

The cited but not applied prior art also includes non-patent literature reference by UPS ([www.ups.com](http://www.ups.com)) and U-PIC ([www.u-pic.com](http://www.u-pic.com)).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Tomaszewski whose telephone number



Art Unit: 3626

is (571)272-8117. The examiner can normally be reached on M-F 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MT



C. LUKE GILLIGAN  
PATENT EXAMINER